

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/783,969 02/16/01 SHERMAN

B PT-1858001

023607  
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175 COMMERCE VALLEY DRIVE WEST  
SUITE 200  
THORNHILL ON L3T 7P6  
CANADA

HM12/0802

AIR MAIL

EXAMINER

KIM, V

ART UNIT

PAPER NUMBER

1614

DATE MAILED:

08/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/783,969

Applicant(s)

SHERMAN, BERNARD CHARLES

Examiner

Vickie Y. Kim

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/403,660.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanak (US 5,639,724) in view of Woo (US 5,589,455).

The claims read on a pharmaceutical composition in the form of an emulsion concentrate comprising a cyclosporin dissolved in a solvent system comprising acetylated monoglycerides, a hydrophilic organic solvent and a surfactant.

Cavanak teaches a pharmaceutical composition comprising cyclosporin as an active ingredient in a carrier(solvent) system comprising a transesterification product(e.g. acetylated monoglyceride), a hydrophilic component(e.g. ethanol, polyol or propylene glycol) and surfactant (e.g. cremophore); see full text and claims, especially column 19, lines 5-15. Acetylated monoglyceride is exemplified as preferred essential component in carrier(solvent) system.

All the elements are taught by the cited reference except that it is silent for the term "microemulsion concentrate" that is required by the instant claims.

However it would have been obvious to one of ordinary skill in the art to extend the Cavanak's teaching to include microemulsion concentrate when Woo's reference is taken

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together because Woo teaches a microemulsion preconcentrate for preparing oral dosage form using the very same or similar ingredients.

Woo teaches a microemulsion preconcentrate comprising cyclosporin, transesterificated compound(e.g. monoglyceides), surfactant(cremophor), hydrophilic component(e.g. propylene glycol); see abstract and examples at columns 22-24. The modification by substituting acetylated monoglyceride to other transesterificated monoglyceride in microemulsion preconcentrate dosage form could be made within the skilled level of artisan where the patentability is merely recognized over the prior art available in the state. Especially, when these references are taken together, the modified composition meets the claims wherein the highly efficient solvent system comprising acetylated monoglyceride, hydrophilic co-solvent(e.g. ethanol or propylene glycol), and surfactant enhanced the bioavailability of cyclosporin much greater than any other commercial product available.

One would have motivated to do so, with reasonable expectation of success because the modified composition provides not only improvement on bioavailability but also lowers the side effects and reduces the costs of the drugs. All the dependent claims properly included in this rejection because all the elements are mentioned in the patented disclosure cited.

One would have been motivated to combine these references and make the modification because they are drawn to same technical fields (constituted with same (or similar) ingredients and share common utilities, and pertinent to the problem which applicant is concerning. MPEP 2141.01(a).

### ***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

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useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1 and 15-21 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9 of prior U.S. Patent No. 6,159,933. This is a double patenting rejection. When two claims in an application are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Each invention claims cyclosporin as an active ingredient, acetylated monoglyceride as a solvent along with hydrophilic component and surfactant.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Conclusion***

All the pending claims are rejected.

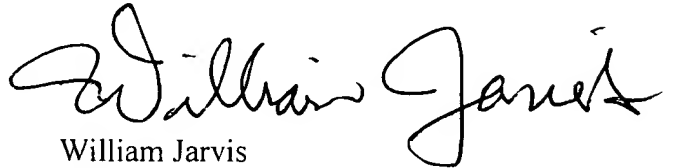
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is (703) 305-1675 (Tuesday-Friday: 8AM-6:30PM) and Fax number is (703) 746-3165.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Vickie Kim,  
Patent examiner  
July 27, 2001



William Jarvis  
Primary examiner  
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